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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/046,998	01/16/2002	Maria Azua Himmel	AUS920010461US1	6338
45440	7590	09/30/2005		
IBM CORPORATION (SS) C/O STREETS & STEELE 13831 NORTHWEST FREEWAY, SUITE 355 HOUSTON, TX 77040			EXAMINER SMITHERS, MATTHEW	
			ART UNIT 2137	PAPER NUMBER

DATE MAILED: 09/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/046,998

Applicant(s)

HIMMEL ET AL.

Examiner

Matthew B. Smithers

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,5,6,10,11 and 14-28 is/are rejected.
- 7) ☒ Claim(s) 2,4,7-9,12 and 13 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>01/16/2002</u> . | 6) <input type="checkbox"/> Other: _____ |

AT

DETAILED ACTION

Information Disclosure Statement

The information disclosure statement filed January 16, 2002 has been placed in the application file and the information referred to therein has been considered as to the merits.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1, 5 and 15 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 7 and 18 of copending Application No. 10/047,005. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations of the instant application are contained in the copending application claims. Claims 1, 5, and 15 of the

instant application are therefore not patently distinct from claims 1, 7, and 18 of the copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 15 recites the limitation "the electronic device " in line 18. There is insufficient antecedent basis for this limitation in the claim.

Claim 15 recites the limitation "the wireless receiver " in line 19. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the electronic device " in line 15. There is insufficient antecedent basis for this limitation in the claim.

Claim 20 recites the limitation "the wireless receiver " in line 16-17. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15-28 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 15 and 20 recite a computer program product including instructions embodied on a computer readable medium. In order for the claims to be statutory, the computer readable medium has to be defined in the disclosure. In view of applicant's disclosure, none of the pages describe a tangible computer readable medium. Without a defined tangible computer readable medium, the claims are sets of instructions (computer program per se), which is not statutory. Further, each of the claims that depend from claims 15 and 20 are also rejected for similar reasons.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1, 3, 5, 15, 17, and 19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent application 2002/0142762 granted to Chmaytelli et al.

Regarding claim 1, Chmaytelli meets the claimed limitations as follows:

"A method for external control over operation of an electronic device having a wireless receiver, comprising:

broadcasting a wireless control message within a broadcast range established by a controlling system, wherein the control message includes an instruction to limit operation of one or more components within the electronic device;" see paragraphs [0038], [0064], [0065], and [0068].

"receiving the instruction in the wireless receiver while the device is located within the broadcast range;" see paragraph [0079].

"and responsive to the instruction, setting one or more electronic gates in the device that control operation of the one or more components." see paragraphs [0080].

Regarding claim 3, Chmaytelli meets the claimed limitations as follows:

"The method of claim 1, wherein the instruction limits operation of two or more of the components within the electronic device." see paragraph [0075].

Regarding claim 5, Chmaytelli meets the claimed limitations as follows:

"The method of claim 1, wherein the electronic device is selected from a telephone, camera, audio recorder, video recorder, and a computer." see paragraph [0028] and figure 1, element 100.

Claims 15, 17 and 19 are computer program product claims that are substantially equivalent to method claims 1, 3 and 5, respectively. Therefore claims 15, 17 and 19 are rejected by a similar rationale.

Claims 1, 3, 5-6, 10-11, 14-15, 17, 19-20, 24-25 and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. patent application granted to Howard et al.

Regarding claim 1, Howard meets the claimed limitations as follows:

"A method for external control over operation of an electronic device having a wireless receiver, comprising:

broadcasting a wireless control message within a broadcast range established by a controlling system, wherein the control message includes an instruction to limit operation of one or more components within the electronic device;" see paragraph [0024].

"receiving the instruction in the wireless receiver while the device is located within the broadcast range;" see paragraph [0028].

"and responsive to the instruction, setting one or more electronic gates in the device that control operation of the one or more components." see paragraph [0031].

Regarding claim 3, Howard meets the claimed limitations as follows:

"The method of claim 1, wherein the instruction limits operation of two or more of the components within the electronic device." see paragraphs [0021].

Regarding claim 5, Howard meets the claimed limitations as follows:

"The method of claim 1, wherein the electronic device is selected from a telephone, camera, audio recorder, video recorder, and a computer." see paragraphs [0002], [0003] and [0015].

Regarding claim 6, Howard meets the claimed limitations as follows:

"A method for external control over operation of an electronic device having a wireless receiver, comprising:

broadcasting a wireless control message within a broadcast range established by a controlling system, wherein the control message includes an instruction to limit operation of one or more components within the electronic device;" see paragraph [0024].

"receiving the instruction in the wireless receiver when the device is located within the broadcast range;" see paragraph [0028].

"communicating the instruction from the wireless receiver to one or more device drivers that operate the one or more components; and refusing commands delivered to the one or more device drivers that violate the instruction." see paragraphs [0030], [0031] and [0032].

"Regarding claim 10, Howard meets the claimed limitations as follows:

"The method of claim 6, wherein the command originates from an application program to request use of one of the components." see paragraphs [0026] and [0028].

Regarding claim 11, Howard meets the claimed limitations as follows:

"The method of claim 6, wherein the instruction limits operation of two or more of the components." see paragraphs [0021].

Regarding claim 14, Howard meets the claimed limitations as follows:

"The method of claim 6, wherein the electronic device is selected from a phone,

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camera, audio recorder, video recorder, and a computer.” see paragraphs [0002], [0003] and [0015].

Claims 15, 17 and 19 are computer program product claims that are substantially equivalent to method claims 1, 3 and 5, respectively. Therefore claims 15, 17 and 19 are rejected by a similar rationale.

Claims 20, 24, 25 and 28 are computer program product claims that are substantially equivalent to method claims 6, 10, 11 and 14, respectively. Therefore claims 20, 24, 25 and 28 are rejected by a similar rationale.

Allowable Subject Matter

Claims 2, 4, 7-9, 12 and 13 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

With respect to claims 2 and 7, the cited prior art fails to specifically teach resetting the one or more electronic gates to a default condition if the wireless receiver does not receive the instruction to limit operation within a preset time period.

With respect to claims 4 and 13 the cited prior art fails to specifically teach automatically resetting the one or more electronic gates to a default condition if the wireless receiver has not received a wireless control message in a preset period of time.

With respect to claim 12, the cited prior art fails to specifically teach wherein the operating limits includes operating limits for one or more of the components, and wherein the operating limits are selected from enable a driver, disable a driver, or combinations thereof.

With respect to claims 8, the cited prior art fails to specifically teach wherein one of the components is a power supply.

With respect to claims 9, the cited prior art fails to specifically teach wherein the instruction sets a power level for one or more components.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

A. Zhang et al (US 2002/0152401) discloses a method for remotely enabling access to inactive software options resident on a device.

B. Haller et al. (US 2003/0035397) discloses a system for providing network services on a mobile device.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew B. Smithers whose telephone number is (571) 272-3876. The examiner can normally be reached on Monday-Friday (8:00-4:30) EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Emmanuel L. Moise can be reached on (571) 272-3865. The fax phone

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number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Matthew B Smithers
Primary Examiner
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